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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,086	05/30/2006	Dominique Jean-Pierre Mabire	PRD-2121 USPCT	1676
27777	7590	02/25/2010		
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER JAISLE, CECILIA M	
			ART UNIT 1624	PAPER NUMBER
			NOTIFICATION DATE 02/25/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jnjuspatent@corus.jnj.com  
lhowd@its.jnj.com  
gsanche@its.jnj.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/596,086	<b>Applicant(s)</b> MABIRE ET AL.	
	<b>Examiner</b> Cecilia M. Jaisle	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 November 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-4,6,12,13,15,16,27,28 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4,6,12,13,15,16,27,28 and 31-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED OFFICE ACTION*****Request for Prior Art***

In accordance with 37 CFR 1.105, Applicants are requested to specifically identify the prior art source of the subject matter excluded by proviso in claim 1, so that further matters of patentability may be considered on this record. MPEP 604.11(b) (III). If the subject matter excluded by proviso in claim 1 is not known in the prior art, Applicants are requested to specifically so state on the record.

***Rejections Under 35 USC 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-4, 6, 12, 13, 15, 16, 27 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 2:**

- When R6 is arylcarbonylpiperidinylalkyl, it is not possible to determine if the arylcarbonyl is on the piperidinyl or on the alkyl.
- When R6 is arylalkyl(alkyl)aminoalkyl, it is not possible to determine if the aryl is on the first alkyl or the last alkyl.
- R3 cannot be the triazole choice, because the triazole choice as illustrated does not have an available bond.

**Claims 12, 27-28:**

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- It is not possible to determine the purpose for which the chemotherapeutic agent is therapeutic.

Any claims not particularly mentioned in this rejection are rejected as dependent on the claims and for the same reasons specifically expressed.

### ***Rejection Under 35 USC 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

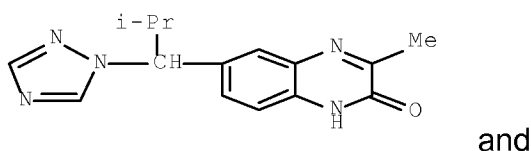
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

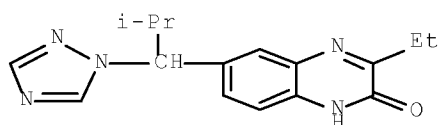
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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freyne, US 5151421, issued 19920929, describing, *inter alia*, RN 130347-01-2, 2(1H)-Quinoxalinone, 3-methyl-6-[2-methyl-1-(1H-1,2,4-triazol-1-yl)propyl]-



RN 130347-78-3, 2(1H)-Quinoxalinone, 3-ethyl-6-[2-methyl-1-(1H-1,2,4-triazol-1-yl)propyl]-



as retinoate metabolism and aromatase

inhibitors. The presently claimed compounds are alkyl homologs and/or position isomers of the Freyne compounds and are well suggested for the same utility.

It would have been obvious to one of ordinary skill in the art when the present invention was made to modify the Freyne compounds to prepare alkyl homologs and position isomers thereof. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such structurally homologous and position isomeric compounds are expected to possess similar properties. It has been held that compounds that are structurally

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homologous and/or position isomeric to prior art compounds are *prima facie* obvious, absent a showing of unexpected results.

An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties.

*In re Payne*, 203 USPQ 245, 254 (CCPA 1979); *In re Papesch*, 137 USPQ 43 (CCPA 1963); and *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1991) (discussed in MPEP § 2144) for an extensive case law review pertaining to obviousness based on close structural chemical compound similarity. See also MPEP § 2144.08, ¶ II.A.4(c). Compounds that are homologs (compounds differing regularly by successive addition of the same chemical group, e.g., by CH<sub>3</sub>- or -CH<sub>2</sub>- groups) and/or position isomers (compounds differing by an adjacent or near adjacent functional group), as here, are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 195 USPQ 426 (CCPA 1977).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cecilia M. Jaisle whose telephone number is 571-272-9931. The examiner can normally be reached on Monday - Friday; 8:30 am through 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding status of an application may be obtained from Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private or Public PAIR. Status information for unpublished applications is available from Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. If you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cecilia M. Jaisle/  
Examiner, Art Unit 1624

**/James O. Wilson/  
Supervisory Patent Examiner, AU 1624**